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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,315	10/22/2001	Vladimir Hampl JR.	SMD-101-CIP	4388

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EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 01/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,315

Applicant(s)

MAPL JR.

Examiner

Carlos Lopez

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: At page 17 line 14, Table 3 only shows a decrease of CO from 13.1 to 10.6 mg/cig not 17.7 to 15.5 mg/cig.

Updated status of the related Applications is required.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 1-2, 4-8, 25-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamazaki et al (WO97/09483). The equivalent US Application of WO97/09483, US 6,138,684, discloses in Tables 1-5 and 9, a control cigarette wrapper having a basis weight of 21gsm, brightness of at least 80% and an opacity at least 80%. Basis weight would include the amount of additive in the paper, subtracting the amount of additive content from the basis weight will provide a fiber basis weight. Therefore, a cigarette paper having fiber basis weight less than 18 gsm as claimed by Applicant would result from the calculations on the amount of additives in the control cigarette paper of tables 1-5 and 9. Hence, the claimed fiber basis weight is anticipated by Yamazaki or at the least is obvious over Yamazaki based on the calculations of the basis weight and additive content of tables 1-5 and 9. For example the control of Table 1 having a basis weight of 21 gsm and a filler content of 26% would therefore have a fiber basis weight of about 15gsm (Fiber basis weight= basis weight $(1-(\% \text{filler content}/100))$).

As for claim 2 and 6, calcium carbonate may be added in any size (Column 3, lines 64-65).

As for claims 4, 7 and 28, the control cigarette paper having the claimed opacity, brightness and grammage would have a fiber basis weight less than about 15gsm (15.3gsm) based on the amount of additives present in the control cigarette paper of Tables 5.

As for claim 5 the white pigment may be added in 10% to 60% by weight (Column 2, line 24).

As for claim 8, alkali metal salts may be added to the to the cigarette paper (Column 2, line 26).

As for claims 25-28, cigarettes are formed with the cigarette paper to obtain the results of Tables 1-9 and would be expected to have the claimed CO delivery of less than 15mg since both the Applicant and Yamazaki et al share the same properties of the cigarette wrapper.

2) Claims 1-2, and 4-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hampl Jr. (US 5,730,840). Hampl discloses a cigarette wrapper having a basis weight range of 18gsm to 60 gsm, a permeability of 5 CU to 80 CU, calcium carbonate filler loading of 20% to 40% having a particle size in the range of .15 microns to .5 microns and an acetate burn control additive of .3% to 12% by weight (Columns 3- 4). Based on the additive content of Hampl (US 5,730,840) and absent any additional additives, is inherent or at least obvious that the fiber basis weight would be less than 18gsm based calculations of said disclosed additive content of the cigarette paper in US 5,730,840. Additionally, since US 5,730,840 shares the claimed filler content, basis weight and filler particle size, the claimed opacity and brightness is inherent in the US 5,730,840 cigarette paper.

As for claim 12, a cigarette wrapper is conventionally used to wrap a smokable filler, tobacco.

As for claims 15-17 and 25, a cigarette having the wrapper of US 5,730,840, and shown to share the claimed additive and basis weight, it would be inherent or expected to have the claimed CO delivery.

As for claims, 10-11, 20-21, and 30, in view that the claimed cigarette paper shares the same filler content, type of filler, basis weight and optical properties, the US 5,893,372 cigarette would be expected to have the claimed tensile strength.

3) Claims 1-30 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hampl Jr. (US 5,893,372). Hampl discloses a cigarette wrapper having a basis weight range of 18gsm to 60 gsm, a permeability of 5 CU to 80 CU, white pigment loading of 20% to 40% having a particle size in the range of .15 microns to .5 microns, an acetate burn control additive (Column 6), opacity at least 80%, and a brightness at least 70% (Columns 3, lines 23-25). Based on the additive content of Hampl (US 5, 893,372) and absent any additional additives, is inherent or at least obvious that the fiber basis weight would be less than 18gsm based on calculations of said disclosed additive content of the cigarette paper in US 5, 893,372.

As for claim 2, the white pigment may be calcium carbonate.

As for claim 3, the white pigment is generic to TiO₂ white pigment conventionally used in the cigarette paper art.

As for claim 12, a cigarette wrapper is conventionally used to wrap a smokable filler, tobacco.

As for claims 15-17 and 25, a cigarette having the wrapper of US 5,893,372, and shown to share the claimed additive and basis weight, it would be inherent or expected to have the claimed CO delivery.

As for claims, 10-11, 20-21, and 30, in view that the claimed cigarette paper shares the same filler content, type of filler, basis weight and optical properties, the US 5,893,372 cigarette would be expected to have the claimed tensile strength.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 9-14, and 18-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5, 8, 15, and 28 of U.S. Patent No. 6,305,382 ('382). Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 5 of the '382 recites the claimed opacity, basis weight, pigment size, tensile strength and brightness (meeting Applicant's limitations of claims 4-7, 10-14, and 18-24) in view of the recited filler content of claim 5 of the '382 patent, the fiber basis weight would be expected to be less


than 18 gsm. As for Applicant's claim 2-3 and 22-23, claim 4 of '382 discloses a white pigment being TiO₂ and calcium carbonate. As for Applicant's claims 9 and 12, additionally reciting the porosity of the wrapper, claim 26 of '382 discloses a smoking article having the claimed permeability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

C.L
January 20, 2003